Petition

81-508

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IN THE
SUPREME COURT OF THE UNITED STATES
October Term, 1981

No. _____

EDWARD M. GOLDBERG, M.D.,

Petitioner,

vs.

MEDTRONIC, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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QUESTIONS PRESENTED FOR REVIEW

1. Can a court of appeals, consistent with the principles of *stare decisis*, prohibit the publication and citation of its opinions?

2. Can a district court, consistent with the Seventh Amendment of the Constitution, prohibit a jury from rendering any decision bearing on the "obviousness" standard of patentability set forth in 35 U.S.C. §103 because, as the district judge said, "I don't want to instruct them with all the garbage that goes with obviousness"?

3. How is the law-fact dichotomy relating to patent validity to be handled before a jury?

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OPINIONS BELOW

The District Court opinion was published at 209 U.S.P.Q. 259 (N.D. Ill. 1980). The appeal was decided by unpublished order.

JURISDICTION

The judgment of the district court was affirmed by the Court of Appeals for the Seventh Circuit in an unpublished order dated April 30, 1981 (A-8)[1]. A Petition for Rehearing was denied on June 12, 1981 (A-15). Jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

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1. "A" refers to the Appendix to this Petition.

CONSTITUTIONAL PROVISION AND STATUTE INVOLVED

United States Constitution

Amendment VII

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

Title 35, United States Code

§103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT OF THE CASE

Petitioner, Dr. Edward M. Goldberg, is an individual inventor who invented a novel heart pacemaker lead that provides an alternative to the major open-heart surgery required to install all earlier myocardial leads.[2] The use of this lead dramatically reduces the trauma associated with the

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2. A "myocardial" lead is one installed on the exterior wall of the heart, and is distinguished from an "endocardial" lead, which is internally installed through the blood vessels leading to the heart.

installation of the lead, and makes pacemakers available to those who are too ill to survive major surgery.

Petitioner obtained United States Patent No. 4,000,745, which covers his lead, and sued Respondent Medtronic for patent infringement. Petitioner demanded a jury trial on all issues triable to a jury.

The case was tried before a jury for approximately four weeks. After all of the evidence was in, a jury instruction conference was held on December 19, 1978. At the jury instruction conference, Petitioner's counsel expressly requested that the Court issue special interrogatories inquiring into one of the "basic factual inquiries" underlying the issue of obviousness,[3] as set forth by this Court in *Graham* v. *John*

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3. 35 U.S.C. §103.

Deere Co., 383 U.S. 1, 17 (1966). Specifically, Petitioner wanted the jury to decide whether certain articles dealing with brain waves and with fluoroscopies were within the "scope and content of the prior art" relating the the obviousness issue.

The trial judge expressly refused to submit such interrogatories, stating that "[t]he special interrogatories are within the discretion of the Court and you are not going to get any."[4] The court also refused to permit a general verdict on the obviousness issue, advising counsel that "I don't want to instruct them with all the garbage that goes with obviousness."[5]

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4. Transcript of Conference held December 19, 1978 (hereafter "Conf."), p. 34, A-3.

5. Conf. p. 30, A-3.

On appeal, Petitioner sought a remand for a new jury trial on the contested fact issues. Respondent relied heavily on another district court opinion in *Hancock Laboratories, Inc. v. American Hospital Supply Corp.*, 199 U.S.P.Q. 279 (N.D. Ill. 1978), stating that the case presented a "uniquely similar fact situation."[6] What Respondent did not know was that *Hancock* had been *reversed* by the Court of Appeals for the Seventh Circuit in an unpublished, unreported order dated May 25, 1979. In that order, the court stated:

> [T]he determination of the scope and content of prior art requires a resolution of questions of fact, *Graham v. John Deere Co.*, 383 U.S. 1 (1965), and we conclude that genuine questions of fact existed as to whether the scholarly articles relied upon by the

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6. Brief for Defendant-Appellee, p. 36.

> defendant anticipated plaintiff's invention . . . .[7]

Petitioner submits that this unpublished order should have been controlling here.

Pursuant to Circuit Rule 35(d)(3), Petitioner moved for an Order that *Hancock Laboratories* be published, or in the alternative, for leave to rely upon the order at oral argument. The motion was denied. (A-6).

On April 30, 1981, the Court of Appeals affirmed the district court, again by unpublished order (A-8). In its opinion, the court blandly tossed aside the central issue on appeal, stating: "Neither special verdicts nor special interrogatories were tendered by plaintiff, perhaps because

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7. Hancock Laboratories, Inc. v. Hospital Supply Corp., No. 78-2218 (7th Cir. 1979)(Unpublished Order).

there really were no salient disputed fact issues for the jury to resolve . . . ." (A-12). This statement, lying at the heart of the court's opinion, was plainly incorrect. In making it, the court ignored the plain fact that the district court had *expressly prohibited* the submission of special interrogatories. The court also ignored the fact that did the district judge refused to let the jury render a general verdict because he did not "want to instruct them with all the garbage that goes with obviousness." A Petition for Rehearing was summarily denied.

REASONS FOR GRANTING THE WRIT

Introduction

The questions presented here are closely related. Petitioner submits that

the practice of deciding cases by unpublished order, at least as applied in the Seventh Circuit, is a gross abuse of the court's general authority to control practice before it. In this case, the Seventh Circuit's refusal to permit the publication or citation of *Hancock Laboratories* allowed the court to ignore a precedent that *Respondent* had urged, before being aware of the reversal, as being "uniquely similar" to the present case. The use of the unpublished order practice in the present case produced a carelessly written opinion which is not only inconsistent with *Hancock Laboratories*, but is also indefensible on its face. The result was an outrageous denial of Petitioner's right to a jury trial. This case further dramatically demonstrates the need for guidance from this court as to the proper handling of the law-fact dichotomy in patent jury trials.

Abuse of the Unpublished Order Practice

All eleven Circuit Courts of Appeals have now adopted rules providing for the non-publication of certain of their opinions which are not considered as having sufficient precedential value to form part of "the stuff of the law."[8] While these rules purport to serve a number of desirable objectives, a mounting tide of evidence and scholarly criticism demonstrates that the negative effects far outweigh any conceivable benefits.[9] In reality, the

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8. *Standards for Publication of Judicial Opinions*, Federal Judicial Center Research Series, No. 73-2, p. 2 (1973); *see generally*, Reynolds, *Non-Precential Precedent--Limited Publication and No-Citation Rules in the United States Courts of Appeals*, 78 Colum.L.Rev. 1167 (1978).

9. *See* Reynolds, *supra*; Reynolds, *Limited Publication in the Fourth and Sixth Circuits*, 1979 Duke C.J. 807; Stern, *The Enigma of Unpublished Opinions*, 64

courts of appeals are developing a body of secret law in which they are permitted to ride roughshod over the principle of *stare decisis*--the keystone of the United States judicial system.

The application of the rule in the Seventh Circuit is particularly onerous.[10] There, a majority of cases is now decided by unpublished order.[11] It is clear that many of these cases deserve publication.

A.B.A.J. 1245 (1978); Flaxman, *Criminal Law & Procedure: Recent Trends in the Seventh Circuit*, 57 Chi-Kent L.Rev. 137 (1981); Note, *A Snake in the Path of the Law: the Seventh Circuit's Non-Publication Rule*, 39 Pitt. L.Rev. 309 (1977).

10. Note, *A Snake in the Path of the Law: The Seventh Circuit's Non-Publication Rule*, 39 Pitt. L.Rev. 309 (1977).

11. *See* Flaxman, *Criminal Law & Procedure: Recent Trends in the Seventh Circuit*, 57 Chi-Kent L.Rev. 137 (1981).

Under the heading "Cites You Should See: Analysis of the Success of the Publication Plan," a recent *Pittsburgh Law Review* note[12] discusses numerous unpublished Seventh Circuit opinions in various fields, giving reasons why they have precedential value. In the patent field, the leading newsletter has seen fit to discuss a number of recent unpublished opinions purportedly having no precedential value.[13] Considering the difficulty of even learning of such opinions, such a fact is surprising indeed.

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12. *Id.* at 315.

13. *E.g.*, Southland Corp. v. Seven-Eleven Supermarkets, Inc., *discussed* 527 Pat. T.M. & Copyright J. (BNA), A-7 (7th Cir. 1981); Celotex Corp. v. Jacuzzi Whirlpool Bath, Inc., *discussed*, 500 Pat. T.M. & Copyright J. (BNA), A-5 (7th Cir. 1980); *see* Mobile Auto Crushers Corp. v. Fjarli, *discussed* 520 Pat. T.M. & Copyright J. (BNA), A-2 (9th Cir. 1981).

This Court has also commented on the Seventh Circuit's abuse of its non-publication rule. In a recent case dealing with prisoners' rights,[14] this Court noted:

> Although petitioner's appeal was decided in an unpublished order purportedly having no precential significance, three members of the Court of Appeals, Chief Judge Fairchild and Judges Swygert and Bauer, nonetheless voted to rehear the case en banc. Judge Swygert filed a written dissent from the order denying the petition for rehearing en banc.[15]

Indeed, this mounting tide of criticism reflects the wisdom of a statement once made by Mr. Justice Stevens:

> [A] rule which authorizes any court to censor the future citation of its own opinions or orders rests on a false

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14. Hughes v. Rowe, 49 U.S.L.W. 3346 (1980).

15. *Ibid.*, n. 3. The decision of significant criminal cases by unpublished order has become a serious problem in the Seventh Circuit. Flaxman, *supra* note 11.

> premise. Such a rule assumes that an author is a reliable judge of the quality and importance of his own work product. If I need authority to demonstrate the invalidity of that assumption, I refer you to a citizen of Illinois who gave a brief talk in Gettysburg, Pennsylvania that he did not expect to be long remembered. Judges are the last persons who should be authorized to determine which of their decisions should be long remembered.[16]

Possibly the most cogent and objective analysis of the problem is that made in an article by Professors Reynolds and Richman,[17] in which they persuasively argue that the unpublished opinion practice is leading to an erosion of judicial respon-

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16. Remarks of Justice Stevens, Illinois State Bar Assn. Centennial Dinner, Jan. 22, 1977, *quoted in* Reynolds, *The Non-Precedential Precedent*, *supra* note 9 at 1192.

17. Reynolds, *Non-Precedential Precedent*, *supra* note 9.

sibility and to a lack of judicial accountability, while aggravating the unfairness which springs from the limited knowledge in the bar regarding a developing body of secret law.

That lack of responsibility and accountability lies at the core of the denial of Petitioner's right to a jury trial. Here, the Court was able to ignore an earlier unpublished case which reached an opposite result on "uniquely similar" facts, while writing an opinion that is patently indefensible. As Professors Reynolds and Richman point out, all of this has occurred in an atmosphere of secrecy and under circumstances which would normally carry a low probability of review by this Court.[18]

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18. "Formally, of course, the courts of appeals are accountable only to the

Denial of Right to a Jury Trial

The denial of Petitioner's right to a jury trial here arose directly from the Seventh Circuit's unpublished opinion practice. The Court was able to ignore the plain fact that Petitioner was denied the right to any jury inquiry into the facts connected with the obviousness issue in one

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Supreme Court. That Court, burdened by its own heavy caseload, husbands its resources by choosing carefully the cases it will review. An unpublished opinion is less likely to be reviewed for several reasons. First, because an unpublished opinion (in most circuits) has no precedential value, the felt need to correct error in such an opinion is less than with published opinions. The Supreme Court is confronted merely with a wrong result, not with 'bad law.' It is not often that the Court will make room on its discretionary and highly crowded docket for a case that merely settles a dispute incorrectly, that is, a case whose error is not likely to be perpetuated in future cases." Richman, *Non-Precedential Precedent*, *supra* note 9 at 1202-03 (footnotes omitted).

careless statement: "perhaps . . . there really were no salient disputed fact issues for a jury to resolve . . . ."

Plainly, there *were* disputed facts, which Petitioner tried to get before the jury either by a general verdict or by special interrogatories. The district court would have none of it, and the court of appeals affirmed in an atmosphere of secrecy, rendering an opinion unlikely to receive outside criticism or further review by this Court. Such a travesty would never have occurred without the cloak of the unpublished order practice employed by the Seventh Circuit.

Need For Guidance From This Court

In addition to the manifest injustice perpetrated here, the Seventh Circuit's opinion points to a larger issue on which

the lower courts badly need guidance. In view of the increasing number of jury trials being demanded in patent cases,[19] there is a need for this Court to define the proper province of the jury when the issue of patent validity is present.

The confusion is generated by the oft-quoted statement in this Court's opinion in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966):

> While the ultimate question of patent validity is one of law, the §103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobvious-

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19. *See* Annual Reports of the Director of the Administrative Office of the U.S. District Courts.

> ness of the subject matter is determined. [Citation omitted.]

While this Court thus held the "ultimate question of patent validity" to be "one of law," and thus a question for the Court, the permissible extent of the jury's inquiry is left in doubt. The law is in a state of total confusion as to whether a jury is permitted to render a general verdict on "the §103 condition" (obviousness),[20] or instead must respond to special

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20. Valtek, Inc. v. Control Components, Inc., 609 F.2d 763 (5th Cir.), *cert. denied*, ____ U.S. ____, 49 U.S.L.W. 3410 (1980); Celebrity, Inc. v. A & B Instrument Corp., 573 F.2d 11 (10th Cir.), *cert. denied*, 439 U.S. 824 (1978); Tights, Inc. v. Acme-McCrary Corp., 541 F.2d 1047 (4th Cir.), *cert. denied*, 429 U.S. 980 (1976); Sperberg v. Goodyear Tire & Rubber Co., 519 F.2d 708 (6th Cir.), *cert. denied*, 423 U.S. 987 (1975); White v. Mar-Bel, Inc., 509 F.2d 287 (5th Cir. 1975); Panther Pumps & Equip. Co. v. Hydrocraft, Inc., 468 F.2d 225 (7th Cir. 1972) (Stevens, J.).

interrogatories probing the "basic factual inquiries"[21] of *Graham*.

While the latter approach now appears to be taking hold in the Seventh Circuit, the quoted portion of *Graham* arises from this Court's strong endorsement of a decision approving a jury instruction which led to a *general verdict* on nonobviousness. That decision was the landmark case of *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851). After an extensive discussion of *Hotchkiss*, this Court stated in *Graham*:

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21. Dual Mfg. & Eng'r., Inc. v. Burris Indus., Inc., 619 F.2d 660 (7th Cir.), *cert. denied*, ____ U.S. ____, 49 U.S.L.W. 3249 (1980); Nickola v. Peterson, 580 F.2d 898 (6th Cir. 1978), *cert. denied*, 440 U.S. 961 (1979); Robbins Co. v. Dresser Indus., Inc. 554 F.2d 1179 (7th Cir. 1976), *cert. denied*, 429 U.S. 985 (1977), Swofford v. B&W, Inc., 395 F.2d 362 (5th Cir.), *cert. denied*, 393 U.S. 935 (1968); Bentley v. Sunset Distrib. Corp., 359 F.2d 140 (9th Cir. 1966).

> We conclude that [section 103] was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability.[22]

No wonder the courts are in confusion! The present case represents a *reductio ad absurdum* of these conflicting views, which led to a *total denial* of petitioner's Seventh Amendment right to a jury trial. The trial court not only refused to permit the rendering of a general verdict ("I don't want to instruct them with all the garbage that goes with obviousness . . . which I think is a purely legal issue"),[23] but also precluded any special interrogatories into the "basic factual inquiries" described in *Graham*.

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22. Graham, 383 U.S. at 17.

23. A-3.

CONCLUSION

This case presents a sorry example of the results springing from the confusion existing in the area of jury trials in patent cases--a total denial of Petitioner's Seventh Amendment rights. This denial was affirmed by the Seventh Circuit in the atmosphere of secrecy promoted by the Seventh Circuit's abuse of its unpublished order practice. That atmosphere permitted that court to render a careless decision affirming the district court, while ignoring the plain facts as well as another unpublished order that demanded a reversal. There can be no doubt of the crying need for this Court to speak on these issues.

Respectfully submitted,

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APPENDIX

[Excerpts from jury instruction conference]

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

EDWARD M. GOLDBERG, Plaintiff,	)	
vs.	)	76 C 246
MEDTRONIC, INC., Defendant.	)	

Before Judge McGarr,
December 19, 1978,
11:00 o'clock a.m.

PRESENT:

Mr. Hofer,

on behalf of plaintiff;

Mr. Jack C. Goldstein,
Mr. John F. Lynch
Mr. Charles De LaGarza
and
Mr. Clark C. King, Jr.,

on behalf of defendant.

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* * *

[p. 30]

MR. HEUSER [co-counsel for Petitioner]: Your Honor, it may be worthwhile to at this point consider the kind of special interrogatories that are going to be required if this form of verdict is going to be used. It appears if this format is going to be followed really are going to have a number of special interrogatories that will be needed.

THE COURT: Why don't I just decide the validity issue but ask the jury to tell me whether the idea of the invention was anticipated, just give them that simple verdict. Tell them what it means and what the law is in considering the facts, and tell me whether they feel that Dr. Goldberg's idea was anticipated by the prior references to it and the literature. It

becomes the form of a special verdict, at least it is a simple one.

MR. HOFER [counsel for petitioner]: If you are going to do that, why don't you ask them at the same time whether it is obvious.

THE COURT: I don't want to instruct them with all the garbage that goes with obviousness, basically, nor with indefiniteness, which I think is a purely legal issue.

* * *

[pp. 33-4]

THE COURT: . . .I am going to try and boil this down to a verdict that the jury can give us, plus all the instructions that they need to give it. The special interrogatories are within the discretion of the Court and you are not going to get any. So it is a question of working out the issues

that have to go to the jury and the verdict they are going to have to give us on those issues.

MR. HEUSER: They certainly can answer what is the level of the skill in the art with a yes or no or anything meaningful.

THE COURT: So the question is, are they entitled to instructions on that by way of deciding the obviousness issue. That is your point.

MR. HEUSER: My point is that we should have to treat these references individually with special interrogatories. It is the only way we can get a meaningful answer back from them.

THE COURT: I don't agree with that. The only meaningful verdict you are going to get from the jury is either yes for Goldberg or no for Goldberg and on what issues, on the issues of validity of the

patent and whether he has some damages coming on a breach of confidential information, and they aren't going to get any help with special interrogatories. All you are going to get is more confusion.

* * *

[p. 107]

MR. LYNCH [counsel for Respondent]: Do I understand nothing will go to the jury, and is that over counsel's objection?

THE COURT: It is over his objection.

MR. HOFER: Yes, it is over my objection.

MR. LYNCH: So nothing on the issue of obviousness goes to the jury -- that is over counsel's objection.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

January 12, 1981

Before
Hon. Robert A. Sprecher, Circuit Judge

EDWARD M. GOLDBERG, M.D., Plaintiff-Appellant,	) Appeal from the) United States) District Court
No. 80-2291 vs.	) for the Northern) District of Ill.,
MEDTRONIC, INC., Defendant-Appellee.	) Eastern Division.) Civ. Action) No. 76 C 246) Frank J. McGarr,) Judge.

This matter comes before the Court for its consideration upon the following documents:

1. "APPELLANT'S MOTION TO HAVE AN UNPUBLISHED OPINION ISSUED AS A PUBLISHED OPINION OR, IN THE ALTERNATIVE, FOR LEAVE TO RELY UPON THE UNPUBLISHED ORDER AT ORAL ARGUMENT" filed herein on December 19, 1980.

2. "OPPOSITION BY APPELLEE TO PUBLICATION OR RELIANCE UPON UNPUBLISHED ORDER AT ORAL ARGUMENT" filed herein on December 23, 1980.

On consideration thereof,

IT IS ORDERED that the motion to have an unpublished order issued as a published opinion or, in the alternative, for leave to rely upon the unpublished order at oral argument is DENIED. However, the parties may inform the panel at the time of oral argument that *Hancock Laboratories, Inc., v. American Hospital Supply Corp.*, published at 199 U.S.P.Q. 279 (N.D. Illinois 1979) has been reversed by an unreported order of this Court.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

Heard February 13, 1981
April 30, 1981

Before
Hon. Walter J. Cummings, Circuit Judge
Hon. Robert A. Sprecher, Circuit Judge
Hon. Willian J. Bauer, Circuit Judge

EDWARD M. GOLDBERG, M.D., Plaintiff-Appellant,	) Appeal from the) United States) District Court
No. 80-2291 vs.	) for the Northern) District of Ill.,
MEDTRONIC, INC., Defendant-Appellee.	) Eastern Division.) Civ. Action) No. 76 C 246) Frank J. McGarr,) Judge.

O R D E R [Unpublished]

Plaintiff, a Chicago physician and professor of surgery, brought this action against defendant, a world-wide biomedical eingineering company based in Minneapolis, Minnesota. Count I of the amended complaint alleged misappropriation of confidential information obtained from plaintiff. The second count asserted that defendant had infringed Claims 1, 5, 10, 11 and 18 of plaintiff's patent No. 4,000,745 for remotely installable electrical leads for cardiac stimulators.

The case was tried before a jury as demanded in the amended complaint, but plaintiff waived his jury demand with respect to Count I since it involved equitable issues. Judge McGarr held for plaintiff on that count and stated that Dr. Goldberg was entitled to 10% of the net profits defendant derived from the sales of defendant's Model 6917 electrode screw-in lead for attaching pacemakers to human hearts. The count found that defendant's gross income from selling its Model 6917 lead prior to the issuance of plaintiff's patent on January 4, 1977, was $12,842,000. The court has not yet determined the precise amount of damages due plaintiff under this common law count which is not involved in this appeal.

As to Count II, the district court directed a verdict in favor of defendant, holding that apparatus Claims 1, 5 and 18 of plaintiff's patent were not infringed for obviousness under 35 U.S.C. § 103. The court decided that there was no just reason for delay in the entry of judgment as to Count II and certified plaintiff's appeal to us under Rule 54(b) of the Federal Rules of Civil Procedure. Plaintiff contends that the issues of infringement and obviousness should have been submitted to the jury. We affirm.

Directed Verdict of Noninfringement

The district court granted defendant's motion for a directed verdict as to infringement for the following reasons:

"And, more specifically, the court having found that Plaintiff Dr. Goldberg is estopped from imposing a construction on claims 1, 5 and 18 which is different from that set forth in the U.S. Patent Office in connection with the limitation of 'longitudinally rigid',

"And it further appearing from the evidence that the said Models 6917 and 6917A are not longitudinally rigid within such meaning of claims 1, 5 and 18." (App. 67A-68B)

We agree that no reasonable man could have found to the contrary so that the district court was correct in directing a verdict that defendant's Models 6917 and 6917A sutureless miocardian leads do not infringe Claims 1, 5 and 18 of plaintiff's patent.

At the December 19, 1978, conference on the issues and instructions, counsel for plaintiff admitted that plaintiff's lead was a longitudinally rigid device which could not be compressed when being used for its intended purpose (App. 41, 42) and that plaintiff had so informed the Patent Office in order to secure his patent over Chardack Patent No. 3,216,424. On the other hand, defendant's lead was not "longitudinally rigid" but was more flexible and resilient than plaintiff's (App. 38, 39). Therefore defendant's lead did not infringe plaintiff's patent.

District Court's Obviousness Decision

The district judge decided that Claims 10 and 11 of plaintiff's patent were invalid for obviousness under 35 U.S.C. § 103. This Court has recently reiterated that the question of obviousness under 35 U.S.C. § 103 "is one of law." *L. E. Sauer Machine Company, Inc. v. Corrugated Finishing Products, Inc.*, ____ F.2d ____, slip op. 4 (7th Cir. February 23, 1981). Plaintiff necessarily agrees with that ruling but contends that there were disputed subsidiary fact questions in this case that should first have been presented to the jury for its findings.

At the instruction conference, counsel for plaintiff suggested that the jury should decide whether the patent was valid or invalid for obviousness after being charged under the three obviousness tests established in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (App. 23-24).[1] However, we recently stated in *Dual Manufacturing & Engineering, Inc. v. Burris Industries*, 619 F.2d 660, 667 (1980), that if subsidiary questions of fact as to obviousness are to be committed to a jury, "its resolution of those issues of fact should be articulated in special verdicts or through special interrogatories" because "when the issue is obviousness, a general verdict, with or

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1. The three *Graham* tests are: scope and content of prior art, differences between the prior art and the claims at issue, and level of ordinary skill in the art.

without answer of special interrogatories, will ordinarily serve no purpose because the court will still have the responsibility of deciding obviousness." Neither special verdicts nor special interrogatories were tendered by plaintiff, perhaps because there really were no salient disputed fact issues for the jury to resolve, plaintiff's protestations notwithstanding. In any event, as then Judge Stevens observed with respect to obviousness:

> "Of course, if there are no disputed fact issues affecting validity, the court may simply instruct the jury that the patent is either valid or invalid." *(Panther Pumps & Equipment Co., Inc. v. Hydrocraft, Inc.*, 468 F.2d 225, 228 n. 8 (7th Cir. 1972)).

That situations prevailed in this case so that there was no error in the court's deciding the obviousness issue without submission to the jury.

In concluding that plaintiff's patent was invalid for obviousness, the court noted that the differences between the methods disclosed in two articles[2] and

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2. Carlsson and Milne, "Permanent Implantation of Endocardial Tantalum Screws: A New Technique For Functional Studies of the Heart in the Experimental Animal," Journal of the Canadian Association of Radiologists (June

plaintiff's patent "would be obvious to a person having ordinary skills in the art of surgery" (App. 18). Then the court added:

> "Any skilled surgeon could easily, or obviously extrapolate from these articles to adopt the methods disclosed to the attachment of helical pacemaker leads to the heart. In other words, 'a hypothetical person, having all of the prior art at hand, would have found the same solution when addressing himself to the same problem.' *Republic Industries, Inc. v. Schlage Lock Co.*, 592 F.2d at 975." (App. 18).

The cited articles show that helically tipped leads were used and that such devices were screwed into organs with the same technique shown in the method claims.

Judge McGarr did not rely on a Japanese article by Tatsuo Togawa entitled "Biological Stimulation Electrode and the Stimulation Threshold - Acute Experiments with Cardiac Pacemaker Electrodes"[3] because

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1967), and Kitahama and Sasoka, "The Spiral Electrode for EEG Recording," 5 Japanese Journal of Medical Electronics and Biological Engineering, No. 3, p. 27 (July 1967).

3. This article appeared in Medical Electronics-Biological Engineering Research Council Papers, Paper No. MB E 67-1 (1967-04) (App. 728).

he was unsure whether the translation of one word meant "screwed in" or "thrust in" (App. 16). Togawa testified that he did screw in electrodes during his experiments, and various translators stated that "screwed into" was the proper meaning of the disputed word "nijikonda." This article props obviousness.

In addition to the above three articles, Quinn Patent No. 3,416,534, which was patented eight years before plaintiff's, discloses that an open helical head can be screwed into the heart wall and used to pace the heart. That patent also supports the district court's conclusion of obviousness.

Judgment affirmed.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

June 12, 1981

Before
Hon. Walter J. Cummings, Circuit Judge
Hon. Robert A. Sprecher, Circuit Judge
Hon. Willian J. Bauer, Circuit Judge

EDWARD M. GOLDBERG, M.D., Plaintiff-Appellant,	Appeal from the United States District Court
No. 80-2291 vs.	for the Northern District of Ill.,
MEDTRONIC, INC., Defendant-Appellee.	Eastern Division. Civ. Action No. 76 C 246 Frank J. McGarr, Judge.

O R D E R

On consideration of the petition for rehearing and suggestion for rehearing *en banc* filed in the above-entitled cause by Edward M. Goldberg, plaintiff-appellant, no judge in active service has requested a vote thereon, and all of the judges on the original panel have voted to deny a rehearing, Accordingly,

IT IS ORDERED that the aforesaid petition for rehearing be, and the same is hereby, DENIED.

CIRCUIT RULES OF THE
UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Effective July 1, 1976

* * *

Circuit Rule 35. The following rule is the Plan for Publication of Opinions of the Seventh Circuit promulgated pursuant to resolution of the Judicial Conference of the United States:

(a) *Policy.* It is the policy of this circuit to reduce the proliferation of published opinions.

(b) *Publication.* The court may dispose of an appeal by an order or by an opinion, which may be signed or per curiam. Orders shall not be published and opinions shall be published.

(1) "Published" or "publication" means:

(i) Printing the opinion as a slip opinion;

(ii) Distributing the printed slip opinion to all federal judges within the circuit, legal publishing companies, libraries and other regular subscribers, interested United States attorneys,

departments and agencies, and the news media;

(iii) Permitting publication by legal publishing companies as they see fit; and

(iv) Unlimited citation as precedent.

(2) Unpublished orders:

(i) Shall be typewritten and reproduced by copying machine;

(ii) Shall be distributed only to the circuit judges, counsel for the parties in the case, the lower court judge or agency in the case, and the news media, and shall be available to the public on the same basis as any other pleading in the case;

(iii) Shall be available for listing periodically in the Federal Reporter showing only title, docket number, date, district or agency appealed from with citation of prior opinion (if reported), and the judgment or operative words of the order, such as "affirmed," "enforced," "reversed," "reversed and remanded," and so forth;

(iv) Except to support a claim of res judicata, collateral estoppel or law of the case, shall not be cited or used as precedent (a) in any federal court within the

circuit in any written document or in oral argument; or (b) by any such court for any purpose.

(c) *Guidelines for Method of Disposition.*

(1) Published opinions:
Shall be filed in signed or per curiam form in appeals which
(i) Establish a new or change an existing rule of law;
(ii) Involve an issue of continuing public interest;
(iii) Criticize or question existing law;
(iv) Constitute a significant and non-duplicative contribution to legal literature
(A) by a historial review of law;
(B) by describing legislative history; or
(C) by resolving or creating a conflict in the law; or
(v) Reverse a judgment or deny enforcement of an order when the lower court or agency has published an opinion supporting the order.

(2) Unpublished orders:
(i) May be filed after an oral statement of reasons has been given from the bench and may include only, or little more than, the judgment rendered in appeals which

(A) are frivolous; or
(B) present no question sufficiently substantial to require explanation of the reasons for the action taken, such as where
(aa) a controlling statute or decision determines the appeal;
(bb) issues are factual only and judgment appealed from is supported by evidence;
(cc) order appealed from is nonappealable or this court lacks jurisdiction or appellant lacks standing to sue; or

(ii) May contain reasons for the judgment but ordinarily not a complete, nor necessarily any, statement of the facts in appeals which
(A) are not frivolous but
(B) present arguments concerning the application of recognized rules of law, which are sufficiently substantial to warrant explanation but are not of general interest or importance.

(d) *Disposition Is To Be by Order or Opinion*

(1) The determination to dispose of an appeal by unpublished opinion shall be made by a majority of the panel rendering the decision.

(2) The requirement of a majority represents the policy of this circuit. Notwithstanding the right of a single federal judge to make an opinion available for publication, it is expected that a single judge will ordinarily respect and abide by the opinion of the majority in determining whether to publish.

(3) Any person may request by motion that a decision by unpublished order be issued as a published opinion. The request should state the reasons why the publication would be consistent with the guidelines for a disposition of appeals as set forth in this rule.

CERTIFICATE OF SERVICE

This is to certify that three copies of the foregoing PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT were served on Defendant-Appellee's attorney by ~~hand-delivery~~ first-class mail, postage prepaid X to Theodore R. Scott, Esq., McDougall, Hersh & Scott, 135 South LaSalle Street, Chicago, Illinois 60603 and mailing three copies, first-class mail, postage prepaid to John F. Lynch, Esq., Arnold, White & Durkee, 2100 Transco Tower, Houston, Texas 77056, this 9th day of September, 1981.

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Opposition

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1981

No. 81-508

EDWARD M. GOLDBERG, M.D.,
Petitioner,

v.

MEDTRONIC, INC.,
Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Seventh Circuit

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

I. STATEMENT OF THE CASE

This is an ordinary patent infringement suit. The patent in suit is United States Patent No. 4,000,745, issued to Edward M. Goldberg. The patent concerns a screw-in type electrode or lead for connection to body organs, such as to connect a heart pacemaker to the heart.

The Petitioner's characterization of the dramatic improvement resultant from his screw-in lead was born of advocacy. In fact the claims to Petitioner's screw-in body organ lead were held obvious in view of screw-in leads of Quinn (U.S. Patent 3,416,534) (DX-18A), and Togawa (1966 Japanese publication) (DX-18G), the screw-in brain lead of Kitahama (1967 Japanese publication) (DX-18I), and the cardiac investigations of Carlsson involving implantation of screws in cardiac tissue (1967 Canadian publication) (DX-18F). The obviousness case was overwhelming.

The case was tried to a jury. Respondent attacked the validity of the patent under 35 U.S.C. §§ 102 and 103. At the jury instruction conference, the Petitioner expressly waived jury submission of issues under 35 U.S.C. § 102.

Petitioner vaguely asserted the existence of a factual dispute as to what art was "analogous." Petitioner never submitted factual issues relating to obviousness which required resolution by the jury. The district court judge demonstrated his sensitivity to permit truly disputed facts to go to the jury. He saw no such factual disputes, and the Petitioner raised none.

The district court held some of the claims of the patent invalid for obviousness under 35 U.S.C. § 103. Other claims in issue were held not infringed by the grant of Respondent's Motion for a Directed Verdict of non-infringement after trial.

The Seventh Circuit Court of Appeals affirmed, holding that no reasonable man could have found to the contrary on the issue of infringement and that there were no fact issues subject to dispute on the issue of obviousness. (See Court of Appeals decision reproduced in Petition at A-10).

II. SUMMARY OF ARGUMENT

Petitioner raises two issues in the guise of three questions presented for review. First, Petitioner asserts that the Seventh Circuit Court of Appeals' policy respecting withholding publication of some opinions is unfair and has prejudiced Petitioner. Secondly, Petitioner suggests he was denied a constitutional right to a jury trial on the issue of obviousness.

The Circuit Court's publication policy has been invoked to give the Petition a veneer of public importance. Respondent had not relied heavily on a prior district court case as Petitioner suggests. In a single nine-line paragraph of a forty-seven page brief Respondent cited the district court case of *Hancock Laboratories, Inc. v. American Hospital Supply Co.*, 199 U.S.P.Q. 279 (N.D. Ill. 1978).

Whether the Courts of Appeals have been uniformly prudent in the application of their non-publication rules is a topic Respondent does not feel compelled to address. In this case there was no significant precedent suppressed or ignored by the Seventh Circuit Court of Appeals.

The second issue is whether the Petitioner was denied his right to trial by jury under the Seventh Amendment. Neither the district court nor the Court of Appeals found any real factual disputes to submit to the jury. Petitioner protests in constitutional argument but failed in two courts below to articulate a question of fact for the jury.

III. ARGUMENT

A. The Rule of The Court of Appeals Has Not Prejudiced Petitioner

1. The Seventh Circuit's Practice Is a Proper Exercise of Its Rule Making Power

As noted below, the unpublished opinion rule is by no means the cornerstone of the Seventh Circuit's affirmance of the district court. Moreover, the Seventh Circuit's rule is not new and similar rules exist in other Circuit Courts of Appeals. (*See* 28 U.S.C. § 2071). This Court itself recognized in *Taylor v. McKeithen*, 407 U.S. 191, 194 n.4 (1972) that "the courts of appeals should have wide latitude in their decisions of whether or how to write opinions."

Jones v. Superintendent, Virginia State Farm, 465 F.2d 1091 (4th Cir. 1972), *cert. denied*, 410 U.S. 944 (1973), discusses and holds constitutional an analogous rule in force in the Fourth Circuit. The necessity of such a procedure brought on by a voluminous number of appeals is undoubtedly greater today than it was in 1972.

The Petitioner's redress for imperfections in the application of the rule, if such exists, should not exist in a writ of certiorari in an ordinary patent infringement suit.

2. The Seventh Circuit Did Not Rely On *Hancock Laboratories* for Its Affirmance of the District Court Nor Was Its Affirmance Inconsistent with the Reversal of *Hancock Laboratories*

Petitioner was allowed to inform the Seventh Circuit at oral argument that the *Hancock Laboratories* case had

been reversed. Hence the Seventh Circuit was aware of the *Hancock Laboratories* case, aware of the extent of reliance on it by the Respondent, and aware of the rationale involved in the case's reversal. The fact that the Petitioner was not allowed to cite the reversal as precedent did not affect the decision of the Seventh Circuit to affirm the district court.

In *Hancock Laboratories, Inc. v. American Hospital Supply Corp.*, 199 U.S.P.Q. 279 (N.D. Ill. 1978), the district court granted the defendant's motion for summary judgment in a patent infringement suit on grounds of anticipation and obviousness. The *only* prior art considered were two articles directed to methods of preserving hearts and heart valves for study. The plaintiff's invention was a device for preparing heart valves for implantation. The district court found that the articles were analogous prior art and held the patent invalid with no trial. The Seventh Circuit reversed the grant of summary judgment.

In the present case, the breadth and scope of the prior art was fully developed during four weeks of testimony. The prior art in this case related to prior screw-in heart leads for pacemakers (Quinn and Towaga), to other heart implantable screws (Carlsson), and to a screw-in brain lead (Kitahama). The relevance of this latter reference is highlighted by the fact that the broad claim of Petitioner's patent is for an electrode for attachment to any body organ, and is not limited to a heart lead.

The Petitioner is seeking no more than a review of facts twice held adversely to him.

B. The Petitioner Was Not Denied His Right to a Trial by Jury

Although *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), speaks in terms of "factual inquiries" with respect to obviousness, the use does not imply that there are factual disputes in the areas of those inquiries in every patent case. In this case the scope of the art and the differences between the art and the claims were beyond dispute. The Court agreed with Petitioner that the level of skill was that of the heart surgeon.

The Seventh Circuit noted that the district judge had followed the procedure of *Graham* in reaching his conclusion of obviousness. Petitioner never submitted special issues on supposedly disputed factual issues relating to obviousness. The Court of Appeals noted that perhaps the reason why Petitioner had not submitted any factual questions for the jury, and does not point them out now is "because there were really no salient disputed fact issues for the jury to resolve, [Petitioner's] protestations notwithstanding." (See Court of Appeals decision reproduced in Petition at A-12).

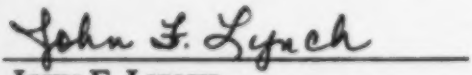
As the Court of Appeals for the Second Circuit commented in *United States v. 243.22 Acres of Land*, 129 F.2d 678, 684 (2d Cir. 1942), *cert. denied*, 317 U.S. 698 (1943):

> There is no constitutional right to have twelve men sit idle and functionless in a jury box.

IV. CONCLUSION

It is respectfully submitted that the Petition for writ of certiorari asserts no grounds upon which the writ should be granted. The decision below is in accord with the law and there is no new issue of significant public moment for this Court to address. The Petition should be denied.

Respectfully submitted,



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